

Application No.: 10/727,518

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REMARKS

Claims 9 and 11-21 are now in the application. Claims 9 and 11-14 are directed to the elected invention. Claims 15-21 are directed to a non-elected invention. The examiner is granted authority to cancel claims 15-21 upon the allowance of the claims directed to the elected invention.

Claim 9 has been amended to recite "Ln represents the natural logarithm" for purposes of clarification and not to limit its scope. Support for this amendment concerning "Ln" is found on line 33 of page 8 of the specification. Claim 9 has also been amended to recite "wherein the catalyst (d) is at least one member selected from the group consisting of perhalogenoic acids or salts thereof, salts of sulfuric acid, salts of phosphoric acid and nitric acid or salts thereof". Support for this amendment concerning "catalyst (d)" is found in Claim 10. In view of this amendment to claim 9, Claim 10 has been cancelled without prejudice to its reentry at some later date. Claim 11 has been amended for purposes of clarification and not to limit its scope to depend from claim 9 because of the cancellation of claim 10. The amendments to the claims do not introduce any new matter.

The rejection of Claims 9-14 under 35 U.S.C. 112, second paragraph has been overcome by the above amendment to claim 9 to recite that "Ln represents the natural logarithm".

Claims 9-13 were rejected under 35 U.S.C. 102(b) as being anticipated by or under 35 U.S.C. 103(a) as being obvious over EP 043,963. EP 043,963 fails to anticipate and fails to render obvious claims 9 and 11-13. EP 043,963 suggests a process for the preparation of nonionic surface active agents which comprises in a first stage, reacting ethylene oxide with a primary monohydric alcohol in the presence of an acid catalyst. The acid catalyst mentioned in the first stage of the process "conveniently can be one of the catalysts such as the fluorides and chlorides of boron, aluminum, iron, tin and complexes of such halides with ethyl ether." EP 043,963 also alludes to the possibility of using sulfuric acid and phosphoric acid.

EP 043,963 fails to disclose the catalyst (d) as now recited in amended Claim 9. Therefore, claims 9 and 11-13 are novel over EP 043,963. EP 043,963 fails to anticipate the present invention since, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir.

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1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. See *Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

Furthermore, it is stated in the Office Action that “the alkylene oxide adduct as taught by ‘963 would inherently have the same distribution constant as recited by the instant claims”. However, ‘963 does not disclose or even remotely suggest the narrow molecular weight distribution of the alkylene oxide adduct as recited in the claims. On the other hand, the alkylene oxide adduct of the present invention has great emulsification and detergency because of the recited narrow molecular weight distribution thereof. On the contrary, ‘963 does not disclose nor suggest emulsification and detergency.

EP 043,963 does not inherently disclose the present invention. For instance, see *In re Robertson et al* 49 USPQ2d 1949 (1999 Fed. Cir.). In this case, Robertson, filed a patent application concerning a paper diaper. The application claimed a paper diaper having (a) two fasteners so that the diaper could be worn on a baby and (b) a third fastener for rolling up and fixing the used diaper. The Patent Office rejected the invention under 35 USC 102 based on “Principles of Inherency” as the invention is “anticipation” by the prior art.

The prior art (Wilson) relied upon disclosed a diaper, which had two snaps in front and back of the diaper in order to be worn by a baby and which may further have a strip in order to fasten the diaper to baby’s body. Wilson describes that the used diaper can be easily dealt with by rolling up and fixing it with the snaps. Accordingly, the Patent Office considered that the diaper of Wilson inherently has an ability to be rolled up and fixed after use and decided that the claimed diaper is anticipated by the diaper of Wilson. The Federal Circuit; however, held that it is recognized that the constitution of the invention is inherently present in the prior art, only when it is clearly shown that the constitution of the invention is necessarily present in the prior art by external evidence. The invention can not be rejected based on “inherency” because of probability or possibility of the presence of the constitution in the prior art. Also see *Crown Operations International Ltd. v. Solutia* 24 USPQ 2d 1917 (Fed. Cir. 2002). Inherency requires that the recited results or structure must necessarily be obtained not merely that it might be

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achieved. See *Electra Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 32 USPQ2d 1017 (Fed. Cir. 1994); and *In re Oelric thh*, 212 USPQ 323 (CCPA 1981).

Accordingly, persons skilled in the art would not expect that an alkylene oxide adduct having the narrow molecular weight distribution is obtained by the reaction of alkylene oxide and alcohol in the presence of the catalyst (d) recited in amended Claim 9 and the obtained alkylene oxide adduct would have great emulsification and detergency.

Therefore, the amended Claim 9 and its dependent Claims 11-13 are nonobvious over EP 043963.

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over EP 043,963 in view of U.S. Patent 3,281,399 to Renaudo et al. (hereinafter "Renaudo"). Renaudo does not overcome the above discussed deficiencies of EP 043,963 with respect to rendering unpatentable claims 9 and 11-13. Renaudo was merely relied upon for a disclosure of removal of catalyst residues from polymers. Accordingly, claim 14 is patentable for those reasons as to why claim 9 is patentable.

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Director is hereby authorized to charge any fees, or credit any overpayment, associated with this communication, including any extension fees, to Deposit Account No. 22-0185.

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Respectfully submitted,


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